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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,912

08/18/2003

Douglas LeCrone

EMC-97-153CON1

3185

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7590

10/06/2006

EMC CORPORATION
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EXAMINER

CHU, GABRIEL L

ART UNIT

PAPER NUMBER

2114

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,912

Applicant(s)

LECRONE ET AL.

Examiner

Gabriel L. Chu

Art Unit

2114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8,9,11,12,14-16,18,19,25,26,28,29,31-33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,9,11,12,14-16,18,19,25,26,28,29,31-33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1 2 8 11 12 14 15 18 19 25 28 29 31 32 35 rejected under 35 U.S.C. 102(e) as being anticipated by US 6216211 to McBrearty et al.** The body of this rejection may be found in the previous office action.
3. **Claims 1 2 8 11 14 16 18 19 25 28 31 33 35 rejected under 35 U.S.C. 102(b) as being anticipated by US 5210865 to Davis et al.** The body of this rejection may be found in the previous office action.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. **Claim 9 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over US 6216211 to McBrearty et al. as applied to claim 1, 18 above, and further in view of US 3704453 to Blackwell et al.** The body of this rejection may be found in the previous office action.
6. **Claim 9 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over US 5210865 to Davis et al. as applied to claim 1, 18 above, and further in view of US 3704453 to Blackwell et al.** The body of this rejection may be found in the previous office action.

7. **Claims 16 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6216211 to McBrearty et al. as applied to claims 11 and 28 above, in view of McBrearty's background.** The body of this rejection may be found in the previous office action.

8. **Claims 12 15 29 32 rejected under 35 U.S.C. 103(a) as being unpatentable over US 5210865 to Davis et al. as applied to claim 11 28 above, and further in view of US 5655154 to Jain et al.** The body of this rejection may be found in the previous office action.

Response to Amendment

9. The declaration filed on 3 August 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the McBrearty reference. Applicant is advised to more closely review MPEP 715.07 and 2138.06, which has been used to determine the ineffectiveness of Applicant's declaration.

10. Applicant appears to be attempting to show Conception with Due Diligence to Constructive Reduction to Practice, as set forth in MPEP 715.07 (III)(C). However, this submission lacks sufficient conception evidence and proof of due diligence.

11. "Conception is more than a vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also". Conception is the formation in the mind of the inventor of a **definite** and permanent idea of the **complete and operative** invention as it is to be thereafter applied in practice, i.e., sufficient for enablement. Source code (which has not been shown) alone generally cannot support the (independent) claim limitations.

12. The critical period for which Applicant must show due diligence is from just prior to the reference date to the filing date of the application. Applicant has left large gaps in the time period provided by the evidence (e.g. 3/13/97 followed by 6/21/97 followed by 12/24/97). Three month gaps without accountability is not an acceptable showing of due diligence. "A 2-day period lacking activity has been held to be fatal." Although proof of reasonable diligence does not require a party to work constantly on the invention or to drop all other work, Applicant must account for the entire "critical period". Periods of inactivity can be excused under certain circumstances such as waiting for ordered parts or for availability of suitable test equipment. Further, patent attorney must prepare applications chronologically, unless work on another application was taken out of turn to contribute to preparation of application under examination.

Response to Arguments

13. Applicant's arguments filed 3 August 2006 have been fully considered but they are not persuasive. Regarding Applicant's argument (page 11) that Davis does not disclose "business continuance features" or "a command processor for implementing business continuance commands to activate those features" further stating that Applicant's summary discloses "business continuance features 'allow[] one or more MVS mainframe hosts to: establish business continuance volumes... split off... and enable a business continuance volume to be used to restore...". Examiner notes that Applicant has not accurately cited Applicant's specification. As argued, it would appear that Applicant is implying that "business continuance features" is a definitively specified

term of Applicant's disclosure that requires the recited functionality. However, upon inspection of the relevant portion of the specification, it becomes clear that Applicant has instead disclosed "a mass storage business continuance time maker function host system that allows one or more MVS main frame hosts to: ..." Examiner further notes that what is actually claimed, in for example claim 1, is "business continuance operations... with business continuance features... comprising a time maker function command processor... implementing business continuance commands..." Clearly, Applicant's specification has not made any limiting definition for the claimed terminology. As such, claim language is interpreted broadly and reasonably.

14. The remainder of Applicant's arguments are based upon Applicant's unclaimed features in accord with the argument addressed above.

15. Examiner further notes that Applicant has applied no arguments to the McBrearty reference.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel L. Chu whose telephone number is (571) 272-3656. The examiner can normally be reached on weekdays between 8:30 AM and 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gabriel L. Chu
Examiner
Art Unit 2114